UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,634	07/26/2001	Wei Yen	196.1004.01	8462

22918 7590 07/24/2006		EXAMINER
PERKINS COIE LLP		HARRELL, ROBERT B
P.O. BOX 2168		
MENLO PARK, CA 94026	ART UNIT	PAPER NUMBER
	2142	

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 May 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>16-21,37-46,48 and 49</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>16-21,37-46,48 and 49</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>22 February 2005</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☒ Other: *see attached Office Action*.

1. Claims 16-21, 37-46, 48 and 49 are presented for examination.

2. The claims must depend in numerical order upon preceding claims (i.e., claim 48 depends on claim 49) and thus claim 48 stands objected to. This can be remedied by canceling claim 48 and introducing such as a new claim 50 dependent upon claim 49.

3. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks ™, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.

4. Indicated allowable subject matter, in the prior Office Action mailed 22 February 2006, is hereby vacated for the following new rejection(s) and grounds of rejection.

5. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology, this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

7. *Claims 16-21, 37-46, 48 and 49 are rejected under 35 U.S.C. 102 (e)* as being anticipated by Kirani et al. (United States Patent Application Publication Number: US 2002/0016818 A1).

8. Per claim 1, Kirani taught a method for sending electronic mail (e.g., see Abstract), including

a) separating at least one attachment from a text portion in an electronic mail message such that a link is created between said at least one attachment and said text portion (e.g., see paragraph [0037]);

b) delivering said at least one attachment at a time other than when said text portion is delivered (e.g., see paragraph [0037]);

c) using a non-email transfer protocol to deliver said at least one attachment (e.g., see paragraph [0029 (i.e., HTML, HTTP (i.e., Web based)], and [0037]);

d) obtaining from a recipient a preferred method for delivery (i.e., "format" per Abstract and paragraph [0029 "World Wide Web"]. [0038]);

e) making said at least one attachment available from said text portion (e.g., see paragraph [0037] URL);

f) publishing said at least one attachment at a location relatively local to said recipient (i.e., storing the attachment at the URL location per Abstract and [0038] in a repository and/or Internet Service Provider and/or mail server);

g) initiating a fetch for said at least one attachment; fetching said at least one attachment; presenting said at least one attachment to said recipient (e.g., the user clicks the URL to get the attachment and the server provides the attachment as stored); and

h) scanning said electronic mail automatically on a regular basis for one of said links embedded in said electronic mail message and pre-fetching an associated attachment to be cached at a location relatively local to recipient (e.g., see figure 5b, specifically 508 "loop").

9.   Per claim 17, claim 18, claim 19, claim 20, and claim 21, figure 3 shows multiple points/locations encompassed by this claim any of which functioned to cache the email close to the recipient.   Since a user of a Service Provider and/or Mail Server contained the user's accounts to which to login, the server was also apart of the recipient thus reaching claim 20 and/or specifically in systems that ran local mail server proxies via "sendmail" or "POP3".

10. Per claims 37-46, 48 and 49, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above. However, per claim 43 and claim 44, Kirani clearly taught probing the recipient in the Abstract, [0038], and other portions, by obtaining user-specified configuration settings. Such setting would indicate if the attachment should be stripped and stored in a different location other than in the same file area as the text portion of the email, such as an intermediate repository location per Abstract. The stripped attachment was then replaced by a preset World Wide Web URL [0029] in the text portion of the email to which the recipient must then go to receive the attachment. Thus, when the recipient required the use of a URL, the attachment was stored (cached) at the intermediate repository location other than the location of the actual text via the World Wide Web [0029] using the HTTP protocol over the SMTP protocol of [0028] using the server's URL after obtaining from a recipient a preferred method for delivery (i.e., formatting per [0038] as an example).

11. *Claims 16-21, 37-46, 48 and 49 are rejected under 35 U.S.C. 102 (e)* as being anticipated by Kaars (United States Patent Application Publication Number: US 2002/0059384 A1).

12. Per claim 1, Kaars taught a method for sending electronic mail (e.g., see Abstract), including
a) separating at least one attachment from a text portion in an electronic mail message such that a link is created between said at least one attachment and said text portion (e.g., see title, Abstract, paragraph [0003], and paragraph [0014]);
b) delivering said at least one attachment at a time other than when said text portion is delivered (e.g., see Abstract and paragraph [0014]);
c) using a non-email transfer protocol to deliver said at least one attachment (e.g., see paragraph [0009]);
d) obtaining from a recipient a preferred method for delivery (e.g., see Abstract and paragraph [0012];
e) making said at least one attachment available from said text portion (e.g., see paragraph [0009] and [0012]);
f) publishing said at least one attachment at a location relatively local to said recipient (i.e., storing the attachment at the URL location per Abstract and [0003]-[0005] and [0011] in a repository and/or Internet Service Provider and/or mail server and/or Web Site);
g) initiating a fetch for said at least one attachment; fetching said at least one attachment; presenting said at least one attachment to said recipient (e.g., the user clicks the URL to get the attachment and the server provides the attachment as stored as anticipated by [0003]-[0005]); and
h) scanning said electronic mail automatically on a regular basis for one of said links embedded in said electronic mail message and pre-fetching an associated attachment to be cached at a location relatively local to recipient (e.g., [0003] and [0009] in that emails are always flowing/incoming and thus figure 1 is reiterated per each email).

13.   Per claim 17, claim 18, claim 19, claim 20, and claim 21, figure 2 shows multiple points/locations encompassed by this claim any of which functioned to "cache" [0011] the email close to the recipient [0013]-[0014].   Since a user of a Service Provider and/or Mail Server contained the user's accounts to which to login, the server was also apart of the recipient thus reaching claim 20 and/or specifically in systems that ran local mail server proxies via "sendmail" or "POP3" per [0013].

14. Per claims 37-46, 48 and 49, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above. However, per claim 43 and claim 44, Kaars clearly taught probing the recipient in the Abstract and [0012], by obtaining user-specified preference(s).   Such preferences in [0012] would indicate if the attachment should be stripped and stored in a different location other than in the same file area as the text portion of the email, such as an intermediate cached location per Abstract and/or [0011]. The stripped attachment was then replaced by a preset World Wide Web URL [0009] in the text portion of the email to which the recipient must then go to receive the attachment. Thus, when the recipient required the use of a URL, the attachment was stored (cached) at the intermediate cached location other than the location of the actual text via the World Wide Web [0003]-[0005] using the HTTP protocol over the SMTP protocol using the server's URL after obtaining from a recipient a preferred method for delivery (e.g., paragraph [0012] as an example).

15. As indicated above, each references obtained from a recipient a preferred method for delivery as in Kirani [0038] where the method is based on a format and in Kaars [0012] the method was replacing the attachment with a World Wide Web URL.

16. *A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the data of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).*

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T. Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (703) 872-9306.

19. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142